

Docket No.: 1907-0230PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Yukitaka SHIMIZU et al.

Application No.: 10/565,853

Confirmation No.: 8106

Filed: January 26, 2006

Art Unit: 3685

For: ACCOUNTING SYSTEM, CONTENT
REPRODUCTION DEVICE, LICENSE
VENDING MACHINE, AND PROGRAM AND
RECORDING MEDIUM

Examiner: K. R. Muhammad

PETITION UNDER C.F.R. § 1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Madam:

Applicants hereby petition to the Director from the Requirement for Restriction (hereinafter "Requirement") dated July 28, 2008, that was made final by the Office Action mailed August 6, 2009. A traverse of this clearly improper Requirement was included with the Reply to Restriction Requirement (hereinafter "Reply") filed August 28, 2008. A Request for withdrawal and reconsideration of the clearly improper requirement and clearly improper Action of December 24, 2008, that ignored the traverse filed with the Reply of August 28, 2008, was included with the response filed March 24, 2009. The improper Requirement was belatedly made final in the outstanding Action of August 6 that was then improperly made final.

DETAILED STATEMENT OF THE FACTS INVOLVED

As noted above, the Requirement of July 28, 2008, required Applicants to make an election as between:

Group I, claims 14, 16, 17, 20-23, 26, 27, 29 and 30, drawn to billing in class 725, subclass 1;

Group II, claims 15, 28 and 33, drawn to usage protection of distributed files classified in class 705, subclass 51;

Group III, claims 18, 19, 31 and 32, drawn to vending in class 235, subclass 381;

Group IV, claim 24, drawn to tokens and smart cards in class 726, subclass 9; and

Group V, claim 25, drawn to copy protection or prevention classified in class 380, subclass 202.

The Requirement stated that these groups were considered “distinct” because these groups (now noted as inventions I-V) were “related subcombinations disclosed as usable together in a single combination.” This allegation was followed by allegations of separate utility for “invention I,” “invention II,” “invention III,” “invention IV,” and “invention V.” This presentation clearly was sufficient to invoke unmentioned reliance on MPEP § 806.05(d) that sets forth the only known authority for requiring restriction when “two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants.”

To whatever degree such criteria can be said to be sufficient to establish “distinctness” as to an application filed under 35 U.S.C. § 111, it is clear that such an alleged MPEP § 806.05(d) showing of distinctness has no applicability to the present Application that is an application filed under 35 U.S.C. § 371. This was pointed out to the examiners in the Reply filed August 28, 2008, as follows:

Applicants traverse this Requirement because this application as been filed in accordance with 35 U.S.C. § 371 (entered the national stage from an international application). Accordingly, 37 C.F.R. § 1.475 and MPEP § 1893.03(d) require that it be shown that this application lacks "unity of invention" as set forth by MPEP §1850.

This traverse and the requirements of 37 C.F.R. § 1.475 and MPEP § 1893.03(d) notwithstanding, the Office Action of December 24, 2008, improperly ignored the requirements of 37 C.F.R. § 1.475 and MPEP § 1893.03(d) and in effect withdrew claims 15, 18, 19, 24, 25, 28, 32, and 33 without any mention of the previous Requirement, the reply, or any basis for ignoring the clear directives of 37 C.F.R. § 1.475 and MPEP § 1893.03(d). As noted above, these last mentioned authorities require a lack of "unity of invention" as discussed in MPEP § 1850 must be shown as to any application filed under 35 U.S.C. § 371.

Consequently, allegations as to MPEP §800 distinctness are insufficient and the Office Action mailed August 6, 2009, committed clear error in once again apparently relying on MPEP § 806.05(d) instead of presenting a Restriction Requirement properly based upon "unity of invention" as fully explained in MPEP § 1893.03(d) and in MPEP § 1850.

REQUEST FOR RELIEF

In view of the above, it is requested that the Restriction Requirement dated July 28, 2008, be reviewed and withdrawn. As a result of this withdrawal, an Action on the merits that properly considers and examines all of pending claims 14-25 and 28-35 of this application and withdraws the improper finality of the Action dated August 6, 2009, is further respectfully requested.

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Petition dated September 30, 2009
Reply to Office Action of August 6, 2009

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CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Jr., Reg. No. 40,440, at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: September 30, 2009

Respectfully submitted,

By 

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